

Application No. 10/680,032
Attorney Docket No. AOL0139

REMARKS

The following remarks are submitted in response to the Office Action mailed May 4, 2007. Reconsideration of the application is respectfully requested.

5 In reviewing the subject specification and associated claims, and based upon the Examiner's comments regarding potential issues with antecedent basis and the need to reword, explain and clarify various terms used in the specification and claims, Applicant has amended several claims to remove any potential confusion and to ensure proper antecedent basis. Applicant believes the various 10 amendments help address many of the issues currently raised by the Examiner, and, correct other potential issues which the Examiner might later note, thereby, placing the Application in condition for allowance.

Information Disclosure Statement

15 Applicant acknowledges that the information disclosure statement filed on 2/27/04 has been considered.

Amendment to Specification

20 The Examiner has objected to line 5 of paragraph 107 on page 31 of the specification for the inclusion of an embedded hyperlink. Applicant has amended the specification to extract the embedded hyperlink, as requested by the Examiner, therefore, the objection has been overcome and Applicant respectfully requests Examiner's approval of the specification, as amended.

25 **Claim Rejections – 35 USC §112**

Claims 4, 5, 10, 12, 25, 29

30 **Claims 4 and 5 –** The Examiner has indicated that he is unsure of the meaning or reference of the term, "the other side" of the session as used in the present application and the referenced claims. The Examiner has also indicated that

Application No. 10/680,032
Attorney Docket No. AOL0139

there is insufficient antecedent basis for the limitation, "message protocol" in Claims 4 and 5. Applicant thanks the Examiner for pointing out the insufficient antecedent basis; Applicant has amended Claims 4 and 5 to correct the antecedent basis. Claims 4 and 5, as presently amended, are reproduced here 5 for convenience:

Claim 4. The system of Claim 1, wherein said activated application agent addresses other said external applications on an the other side of said session via a the user's message protocol.

10 Claim 5. The system of Claim 4, wherein the data transferred via the said user's message protocol for addressing other said external applications on the said other side of said session is a sequence of characters that represents binary data.

15 Support for the above amendment of Claims 4 and 5 can be found at least at page 12, lines 13-25, and page 13, lines 1-10 of the Specification where Applicant states (emphasis added):

20 "In order to avoid possibility of security flaws, a **protocol**, deployed on top of the IM application, is required. The **protocol** supports the relationships among the users for the IM session, the agent, i.e. the IMLet, representative of the external entity, i.e. an application software or service, and the agent's action. This **protocol** adds meta-data that is pertinent to the agent for the given user session. Assume a word processor is involved, the message between User A and User B would become:

25 AgentFrom:Word_Processor;
 AgentTo: Word_Processor;
 SessionInstance: 1;
 Agent_Command: Save_file;
 ...
 ...

Application No. 10/680,032
Attorney Docket No. AOL0139

This represents a message that was sent from, for example, the device 11, User A, via IMLet word processor, addressing the same agent **on the other end** (the device 12, User B). This type of agent-to-agent message using IM session works in the communication **protocol** level without showing as text to the users. Note that the IMLet, which operates as agent in the user's IM session, also addresses other applications **on the other side** via using the user's communication channel and a **message protocol**. Particularly, the IMLet sends encoded data via the user's **message protocol**. For example, when application A is addressing Application B **on the other end**, the data transferred can be a sequence of characters that represents binary data."

As is well known in the context of instant messaging technology, an IM session is a communication instance between two or more users of the instant messaging application. As used herein, the number of "sides" of a session is defined by the 15 number of users. For example, when two users are communicating during an IM session, there are two sides to the session. For each of the two users, there is only one "other side" of the session. If three users are engaged in an IM session, likewise, there are three sides of the session; each individual user has two "other sides" to the session.

20 As is also well-known in the art, a "protocol" is an agreed-upon format for transmitting data between two devices or applications. A protocol may be used, for example, to determine the type of error-checking to be used between at least two communicating devices, which data compression method to use when 25 communicating, how a sending device will indicate that it has finished sending a message, how a receiving device will indicate that it has received a message, or how one application will communicate with another application residing locally or elsewhere. There are a variety of standard protocols from which a programmer can choose to establish a communication modality between different devices. 30 Effectively, a protocol constitutes a language used to communicate between devices or applications.

Application No. 10/680,032
Attorney Docket No. AOL0139

The limitations of Claim 4 describe that an application agent resident with one user of the instant messaging application will use the message "protocol" to address an application associated with another user on "the other side" of the instant messaging session. Additionally, the limitations of Claim 5 provide that 5 data transferred by the message "protocol" to address an application on "the other side" of a session is a sequence of characters representing binary data.

Having clarified the meaning of the terms, "the other side" and "message protocol" as used in the present Application as well as Claims 4 and 5, and, 10 having corrected the antecedent basis for those same terms, Applicant respectfully requests the withdrawal of the Examiner's §112 rejection of Claims 4 and 5 and passage of the claims to allowance.

Claims 10, 12, 25, and 29 – The Examiner has indicated he is unsure of the 15 meaning and use of the term, "stacked," in the context of the present application and the referenced claims. Applicant appreciates the opportunity to clarify the term for the Examiner. As indicated in the online encyclopedia, TechEncyclopedia, at the URL, <http://www.techweb.com/encyclopedia>, an accepted definition of the term "stack" in the context used in the Application is as 20 follows:

Application stack - The set of applications typically required by an organization. A typical "enterprise" application stack would include the basic office functions (word processing, spreadsheet, database, etc.), as well as a Web browser and e-mail and instant messaging programs. **"Stack"** has become a popular term for 25 suite, set or group of software.

In the context of the claimed invention, Applicant primarily uses the term "stacked" to indicate that an external application associated with the messaging application can run simultaneously with and in collaboration or in conjunction with 30 the messaging application and hence, does not require that the instant messaging session or the instant messaging application be terminated to execute or interact with the external application. However, Applicant also uses

Application No. 10/680,032
Attorney Docket No. AOL0139

the term "stacked" to signify that when an application is "stacked" on the messaging application, it appears in the user's graphical user interface and is "immediately available for the user". Applicant has amended all claims to remove the term, "stacked" to avoid any confusion. As shown at page 6, lines 8-11 of

5 Applicant's Specification (emphasis added):

"In one preferred embodiment of the invention, the rich experience framework includes a graphical user interface which has a window for registration and activation of the software agents. The graphical user interface can be either attached to, or detached from the traditional instant messenger interface.
10 **Registration of a software agent makes it immediately stacked on the user's instant messenger application environment and thus makes a third-party service represented by the agent immediately available for the user.**
The user chooses one or more software agents for registration from a variety of options. A list of the options is frequently updated by the IM service provider. The
15 user may change his registrations from time to time."

Having clarified the meaning of the term "stacked" as used in the present Application and having amended and reworded the referenced claims to remove the use of the term, "stacked," thereby avoiding any potential ambiguity and to
20 more particularly point out and distinctly claim the subject matter of Applicant's invention, Applicant respectfully requests the withdrawal of the Examiner's §112 rejection of Claims 10, 12, 25, 29 and passage of the claims to allowance.

25 **Claim 25 – The Examiner indicates that he believes the term, "the users" may be used erroneously and that there is insufficient antecedent basis for the limitation in the claim. Applicant wishes to confirm that the term has been used as originally intended, but, agrees that the lack of proper antecedent basis pointed out by the Examiner may have caused some confusion. Consequently, Applicant has amended Claim 25 and changed "the users" to "a user" to provide proper
30 antecedent basis and clarify the meaning of the term.**

Application No. 10/680,032
Attorney Docket No. AOL0139

Having corrected the antecedent basis of Claim 25 which Applicant believes simultaneously removes any confusion as to the use or meaning of the term, "users," Applicant respectfully requests the withdrawal of the Examiner's §112 rejection of Claim 25 and passage of the claim to allowance.

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Claim Rejections - 35 U.S.C. § 102 (e)

Claims 1-4, 11-12; and 25-28

Claims 1-4, 11-12; and 25-28 stand rejected as being anticipated under 35 U.S.C. §102(e) by Yairi et al, U.S. Patent Number 20040078424, hereinafter, "Yairi". M.P.E.P. §2131 provides that, to anticipate a claim, a prior art reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully traverses the present rejection and asserts that the subject claims are patentably distinguishable from the disclosure of Yairi. Further, Applicant contends that the single reference of Yairi fails to teach or enable each of the claimed elements of Applicant's invention as arranged in Applicant's claims. Consequently, Applicant submits that the Examiner has failed to establish a prima facie case of anticipation under §102(e) and the rejection of all of Claims 1-4, 11-12; and 25-28 is deemed overcome.

Claim 1 – Unlike Yairi, the claimed invention teaches a system supporting two or more users engaged in an instant messaging session wherein any of the users may access and activate one or more application agents which are each associated with an external application. In particular, the claimed invention further includes the limitation that, whenever any of the application agents is activated, the external application is displayed on all user screens such that all users in the instant messaging session can immediately use that same external application, and, can do so without leaving the current instant messaging

Application No. 10/680,032
Attorney Docket No. AOL0139

session. Additionally, the claimed invention allows a plurality of instant messaging users engaged in the same instant messaging session to simultaneously communicate with each other, to access and share any activated external application associated with any of the other users, and, to do so without 5 shutting down the instant messaging session between the users.

Yairi describes merely a simplistic text-based messaging system for mobile devices where an individual user may access an external web service by treating the web service as another "virtual" instant messaging user. Yairi fails to teach 10 that ALL users in a session can share a plurality of external applications without having to leave that session, as in the claimed invention. Further, Yairi does not teach "application agents" associated with "external applications" wherein activation of an agent causes the associated external application to be displayed in conjunction with the client messaging application such that all users in the 15 instant messaging session can use the external application as in the claimed invention; Yairi discloses only a single interface for access to "web services".

Further, Yairi requires a separate "gateway data processing device," i.e., an "Instant Messaging Web Services (IM/WS) Gateway 101", to serve as an 20 intermediary between IM users and web services (see Yairi, paragraphs 10 and 23). The system of Yairi further requires a separate proxy module as part of the gateway to translate and reformat messages to be accepted by the mobile IM user (Yairi, paragraph 10). Yairi treats a web service as simply a separate virtual IM user and does not disclose allowing multiple external applications to run on 25 top of the messaging application for use by all users in a session. The environment described by Yairi is limited to converting the output of a "web service" to a text message format, whereas, the claimed invention supports access to the entire richness of an external application which can be shared by all users in the instant messaging session.

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Application No. 10/680,032
Attorney Docket No. AOL0139

Consequently, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of anticipation, and therefore, Claim 1 is in proper condition for allowance. Applicant, therefore, requests the withdrawal of the Examiner's §102 rejection of Claim 1 and passage to allowance.

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Claim 2 – Applicant respectfully traverses the rejection of Claim 2 by Examiner.

Applicant has reviewed the portions of Yairi cited by the Examiner as describing the limitations of Claim 2, but has been unable to identify any teaching in either paragraphs 9 or 25 describing the limitation, either expressly or implicitly,

10 "wherein said external application is either a local application in the user's device or a third party service on the global network." Consequently, Applicant respectfully submits that Claim 2 is not anticipated by the disclosure of Yairi, and hence, is allowable for the stated reasons, in addition to its dependency from parent Claim 1, which is likewise deemed allowable.

15

Claims 3-4, 11-12 - Applicant has incorporated the limitation of Claim 11 in parent Claim 1 and cancelled Claim 11, therefore the rejection of Claim 11 is now moot. Based on Applicant's contention that independent Claim 1 is deemed allowable as amended; dependent Claims 3-4 and 12 are likewise deemed 20 allowable due to their dependency from allowable parent Claim 1.

Claim 25 - As to independent Claim 25, Applicant contends that Claim 25 is likewise allowable for at least the same reasons as those described above concerning the allowability of independent Claim 1. In reviewing Claim 25,

25 Applicant noted the need to correct certain antecedent references and has therefore amended Claim 25 to correct those references. Claim 25, as currently amended, reads as follows:

30 A method for incorporating external resources into an instant messaging session supported by an instant messaging system, said instant messaging system comprising a client messaging application which runs on a number of devices communicatively coupled to the Internet, comprising the steps of: said client

Application No. 10/680,032
Attorney Docket No. AOL0139

messaging application providing a user interface displayed on each device's screen from which ~~a the user[e]~~ communicate[s] with each other users, said user interface comprising a message entry window for said the user to enter data, a communication window for displaying messages entered in said instant messaging a session, and a selection window for accessing one or more application agents, each of said application agents being associated to an external application, the method further comprising the steps of: activating a registered application agent from a list of registered application agents, wherein each of said registered application agents is ~~stacked on said client messaging application~~ and is instantly available to be activated by the said user; and sharing the said external application to which said activated application agent is associated with other users in said instant messaging session.

Based on the above amendments and for the reasons stated with regard to Claim 1, Applicant respectfully submits that Claim 25 is now in proper condition for allowance and requests the Examiner's withdrawal of the rejection under §102(e).

Claims 26-28 - Since independent parent Claim 25 is deemed allowable, Applicant respectfully submits that dependent Claims 26-28 are likewise allowable due their dependency from parent Claim 25.

Claims Rejection - 35 U.S.C. § 103(a)

Claims 5 - 10, 13 - 24 and 29 – 33

Applicant respectfully traverses the rejection of Claims 5-10, 13-24 and 29-33 under 35 U.S.C. §103. The rejection of any claims under 35 U.S.C. §103 (a) is deemed moot since it is Applicant's belief and contention, based upon at least the above arguments, that parent independent Claims 1 and 25 of the claimed invention are now allowable, and therefore, associated dependent Claims 2-10, 12-24 and 26-33 are likewise allowable due to their dependency from Claims 1 and 25, respectively.

Application No. 10/680,032
Attorney Docket No. AOL0139

Conclusion

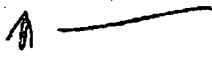
Applicant submits that independent Claims 1 and 25 are allowable for at least the reasons stated above. Accordingly, dependent Claims 2-10, 12-24 and 26-33 5 are allowable at least for the same reasons as their respective parent independent claims.

All objections and rejections having been addressed, Applicant respectfully requests favorable consideration of the above remarks, withdrawal of the present 10 objections and rejections, and passage of Claims 1-10 and 12-33 to allowance. Applicant submits that the instant application is now in condition for allowance and respectfully solicits prompt notification of the same.

Should the Examiner deem it helpful to advance the instant application to 15 allowance, the Examiner is encouraged and cordially invited to contact Applicant's attorney, Michael A. Glenn at (650) 474-8400.

Respectfully submitted,

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